

ESTTA Tracking number: **ESTTA496014**

Filing date: **09/24/2012**

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD

## Notice of Opposition

Notice is hereby given that the following party opposes registration of the indicated application.

### Opposer Information

Name	Aeropostale Procurement Company, Inc.
Granted to Date of previous extension	09/23/2012
Address	112 W. 34th Street, 22nd Floor New York, NY 10120 UNITED STATES
Correspondence information	Katten Muchin Rosenman LLP 575 Madison Avenue New York, NY 10022 UNITED STATES jan.tamulewicz@kattenlaw.com Phone:212-940-8673

### Applicant Information

Application No	79096885	Publication date	03/27/2012
Opposition Filing Date	09/24/2012	Opposition Period Ends	09/23/2012
International Registration No.	1075745	International Registration Date	03/08/2011
Applicant	FGF Industry S.p.A. Vicolo Bellini, 12 I-35121 PADOVA ITALY		

### Goods/Services Affected by Opposition


Class 025. All goods and services in the class are opposed, namely: Clothing, namely, raincoats, shirts, jumpers, pullovers, dresses, shorts, trousers, suits, scarves, skirts; and clothing made of leather, namely, footwear, gloves, belts, jackets, coats, trench coats, and headwear
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### Grounds for Opposition

Priority and likelihood of confusion	Trademark Act section 2(d)
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### Marks Cited by Opposer as Basis for Opposition


U.S. Registration No.	2911335	Application Date	03/13/2000
Registration Date	12/14/2004	Foreign Priority Date	NONE
Word Mark	AERO		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 2004/01/12 First Use In Commerce: 2004/01/12 CHILDREN'S CLOTHING, NAMELY, SHIRTS, PANTS, JACKETS, VESTS, SOCKS, CAPS, HATS, JEANS, SWEATERS, SWEATSHIRTS, T-SHIRTS, TOPS, WARM-UP SUITS

U.S. Registration No.	2937762	Application Date	08/19/2003
Registration Date	04/05/2005	Foreign Priority Date	NONE
Word Mark	AERO		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2003/01/14 First Use In Commerce: 2003/01/14 Clothing namely t-shirts		

U.S. Registration No.	2927817	Application Date	07/09/2003
Registration Date	02/22/2005	Foreign Priority Date	NONE
Word Mark	AERO ATHLETICS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2001/10/28 First Use In Commerce: 2001/10/28 Clothing, namely, shirts, sweatshirts, t-shirts, sweat pants, tank tops, jackets, caps, pants and shorts		

U.S. Registration No.	3321655	Application Date	05/23/2006
Registration Date	10/23/2007	Foreign Priority Date	NONE
Word Mark	AERO SAND SPEAKERS		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2007/02/28 First Use In Commerce: 2007/02/28 Footwear		

U.S. Registration No.	3289070	Application Date	05/23/2006
Registration Date	09/04/2007	Foreign Priority Date	NONE
Word Mark	AERO DUO CAP		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2006/06/12 First Use In Commerce: 2006/06/12 Headwear		

U.S. Registration No.	1354292	Application Date	10/05/1984
Registration Date	08/13/1985	Foreign Priority Date	NONE
Word Mark	AEROPOSTALE		

Design Mark	
Description of Mark	NONE
Goods/Services	Class 025. First use: First Use: 1984/08/01 First Use In Commerce: 1984/08/01 MEN'S APPAREL, NAMELY JACKETS

U.S. Registration No.	1485368	Application Date	08/19/1987
Registration Date	04/19/1988	Foreign Priority Date	NONE
Word Mark	AEROPOSTALE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1987/07/01 First Use In Commerce: 1987/07/01 LADIES' APPAREL, NAMELY, T-SHIRTS, SHIRTS, BLOUSES, SWEATERS, PANTS; MEN'S APPAREL, NAMELY, JEANS, SWEATERS, SHIRTS, SWEATSHIRTS, T-SHIRTS		

U.S. Registration No.	1525345	Application Date	02/01/1988
Registration Date	02/21/1989	Foreign Priority Date	NONE
Word Mark	AEROPOSTALE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 009. First use: First Use: 1987/12/01 First Use In Commerce: 1987/12/01 SUNGLASSES Class 025. First use: First Use: 1987/11/15 First Use In Commerce: 1987/11/15 BELTS, SOCKS AND CAPS Class 034. First use: First Use: 1987/12/01 First Use In Commerce: 1987/12/01 CIGARETTE LIGHTERS		

U.S. Registration No.	1548372	Application Date	02/01/1988
Registration Date	07/18/1989	Foreign Priority Date	NONE
Word Mark	AEROPOSTALE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 1987/10/15 First Use In Commerce: 1987/10/15		

	BOY'S APPAREL, NAMELY, JACKETS, JEANS, PANTS, TOPS, SHIRTS, SWEATERS; GIRLS' APPAREL, NAMELY, SHIRTS, JACKETS, JEANS, SKIRTS, SWEATERS
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U.S. Registration No.	3384078	Application Date	12/19/2006
Registration Date	02/19/2008	Foreign Priority Date	NONE
Word Mark	AÃ#ROPOSTALE		
Design Mark			
Description of Mark	The mark consists of the word "AEROPOSTALE" and a butterfly graphic design.		
Goods/Services	Class 025. First use: First Use: 2005/09/01 First Use In Commerce: 2005/09/01 Clothing, namely, shirts, polo shirts, jeans, shorts, skirts, pants, sweaters, camisoles, pajamas, sweat pants, socks, intimate apparel, namely, under wear, under pants		

U.S. Registration No.	3444014	Application Date	05/22/2007
Registration Date	06/10/2008	Foreign Priority Date	NONE
Word Mark	AEROPOSTALE		
Design Mark			
Description of Mark	NONE		
Goods/Services	Class 025. First use: First Use: 2002/01/31 First Use In Commerce: 2002/01/31 Footwear, namely, slippers, flip-flops, sandals, espadrilles, and wedges		

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## Certificate of Service

The undersigned hereby certifies that a copy of this paper has been served upon all parties, at their address record by First Class Mail on this date.

Signature	/Jan Tamulewicz/
Name	Katten Muchin Rosenman LLP
Date	09/24/2012

**IN THE UNITED STATES PATENT AND TRADEMARK OFFICE  
BEFORE THE TRADEMARK TRIAL AND APPEAL BOARD**

Aéropostale Procurement Company, Inc.,	)	
	)	
Opposer,	)	Opposition No. _____
	)	
v.	)	<b>Mark: AERO LEATHER</b>
	)	<b>CLOTHING CO</b>
	)	<b>and Design</b>
	)	
FGF Industry S.p.A.	)	App. No.: 79/096,885
	)	
Applicant.	)	

**FILED ELECTRONICALLY VIA ESTAA**

**NOTICE OF OPPOSITION**

In the matter of U.S. Trademark Application Serial No. 79/096,885 for the mark AERO LEATHER CLOTHING CO and Design, filed March 8, 2011 by FGF Industry S.p.A. ("Applicant") for use in connection with "Clothing, namely, raincoats, shirts, jumpers, pullovers, dresses, shorts, trousers, suits, scarves, skirts; and clothing made of leather, namely, footwear, gloves, belts, jackets, coats, trench coats, and headwear, in International Class 025" and published for opposition in the U.S. Patent and Trademark Office on March 27, 2012, Aéropostale Procurement Company, Inc. ("Opposer"), a corporation organized and existing under the laws of the State of Delaware, having an address at 112 West 34<sup>th</sup> Street, 22<sup>nd</sup> Floor, New York, New York 10120, believes that it will be damaged by registration of this mark and hereby opposes the same.

The grounds for the opposition are as follows:

1. Opposer, by and through its parent and affiliates, is a leading designer, manufacturer and retailer of high-quality, active-oriented, fashion merchandise and accessories. For well over two decades, Opposer has advertised, promoted and sold a comprehensive range of apparel and accessories under its famous and federally registered AERO and AEROPOSTALE names and marks.

2. Opposer operates over 980 AEROPOSTALE stores across the United States, Puerto Rico, and Canada, all featuring Opposer's fashion merchandise and accessories bearing Opposer's federally registered AERO and AEROPOSTALE names and marks.

3. In connection with its business, Opposer is the owner of multiple federal trademark registrations for its AERO and AEROPOSTALE names and marks covering a wide

range of apparel and accessories products and retail store services (collectively, the “AERO Registrations”), including, among others, the following:

- U.S. Trademark Registration No. 2,911,335 for the mark AERO, issued December 14, 2004;
- U.S. Trademark Registration No. U.S. Registration No. 2,937,762 for the mark AERO and Design, issued April 5, 2005;
- U.S. Registration No. 2,927,817 for the mark AERO ATHLETICS, issued February 22, 2005;
- U.S. Registration No. 3,321,655 for the mark AERO SAND SPEAKERS, issued October 23, 2007;
- U.S. Registration No. 3,289,070 for the mark AERO DUO CAP, issued September 4, 2007;
- U.S. Registration No. 1,354,292 for the mark AÉROPOSTALE, issued August 13, 1985.
- U.S. Registration No. 1,485,368 for the mark AÉROPOSTALE, issued April 19, 1988.
- U.S. Registration No. 1,525,345 for the mark AÉROPOSTALE, issued February 21, 1989.
- U.S. Registration No. 1,548,372 for the mark AÉROPOSTALE, issued July 18, 1989.
- U.S. Registration No. 3,384,078 for the mark AÉROPOSTALE, issued February 19, 2008.
- U.S. Registration No. 3,444,014 for the mark AÉROPOSTALE, issued June 10, 2008.

4. Each and all of the AERO Registrations are valid and subsisting and in full force and effect, and are conclusive evidence of Opposer’s right to use said marks in commerce on and in connection with the goods and services listed therein.

5. By virtue of their many years of use and the wide renown acquired by each of Opposer’s AERO and AÉROPOSTALE trademarks, these marks have developed a secondary meaning and significance to the public and the trade. Consumers have come to recognize goods and services identified by the AERO and AÉROPOSTALE names and marks (including, in particular, apparel) only with Opposer.

6. Since its initial use of Opposer’s AERO Marks, Opposer has continually used, advertised, promoted and offered Opposer’s apparel products bearing its AERO Marks to the



public, with the result that members of the relevant consuming public have come to know and recognize Opposer's AERO Marks and associate them with Opposer and the apparel products offered by Opposer. Opposer has established goodwill in connection with the advertising, marketing, promotion, rendering, distribution and sale of products under each and all of its AERO Marks.

7. Prior to Applicant's filing date or any priority date that may be claimed by Applicant, Opposer has used, and is now using the AERO Marks in connection with apparel products offered by Opposer in commerce. Opposer's use of the AERO Marks has expanded over time to include a range of different apparel products and accessories.

8. Upon information and belief, long after the adoption and use by Opposer of the AERO Marks, Applicant filed the instant Application seeking registration of the mark AERO LEATHER CLOTHING CO and Design for use on and in connection with clothing, including a wider range of apparel in International Class 25."

9. The goods covered by the AERO LEATHER CLOTHING CO and Design Application are identical to those offered by Opposer under its AERO mark, namely, apparel.

10. Applicant's AERO LEATHER CLOTHING CO and Design mark is a simulation and colorable imitation of, and so resembles Opposer's AERO Marks as to be likely, when applied to the International Class 25 goods of Applicant, to cause confusion or mistake or to deceive the relevant consuming public resulting in damage and detriment to Opposer and its reputation, in violation of Section 2(d) of the Trademark Act, 15 U.S.C. § 1052(d). Confusion is particularly likely because the Applicant's mark is a combination of Opposer's AERO trademark and the descriptive terms "leather" and "clothing," the very type of products that Opposer has sold under its marks for twenty years. Moreover, Applicant expressly disclaimed the phrase "LEATHER CLOTHING CO," relying entirely on the trademark significance of the AERO mark which is uniquely identified with Opposer.

11. Upon information and belief, Applicant intends to promote and offer for sale its apparel products to the same and/or highly related general classes of consumers to which Opposer promotes and sells its products.

12. Upon information and belief, members of the relevant consuming public are likely to be confused, mistaken or deceived as to the origin and sponsorship of Applicant's goods marketed under Applicant's alleged AERO LEATHER CLOTHING CO mark and misled into believing that such goods are produced by, emanate from, or are in some way associated with Opposer, to the damage and detriment of Opposer and its reputation.

13. Opposer will be damaged by the confusion which will result in the marketplace if the Applicant is permitted to register the AERO LEATHER CLOTHING CO mark for the specified goods in International Class 25 and therefore, Opposer is likely to suffer damage and/or injury to its reputation and goodwill as a result thereof.

WHEREFORE, Opposer believes that it will be damaged by registration of the AERO LEATHER CLOTHING CO mark, and respectfully requests that the mark shown in U.S.

Trademark Application Serial No. 79/096,885 be refused registration in International Class 25 and that this Opposition be sustained.

Respectfully submitted,  
KATTEN MUCHIN ROSENMAN LLP  
Attorneys for Opposer  
575 Madison Avenue  
New York, New York 10022-2585  
(212) 940-6365

By: 

Jan Tamulewicz

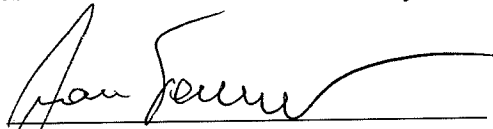
September 24, 2012

**CERTIFICATE OF SERVICE**

I hereby certify that I have caused a true and correct copy of the Notice of Opposition against Application Serial No. 85/550,346 to be served upon:

Kristine L. Butler, Esq.  
Volpe and Koenig, PC  
30 S. 17th Street  
Philadelphia PA 19103-4009

by placing same in an envelope, properly sealed and addressed, with postage prepaid and depositing same with the United States Postal Service on this 24<sup>th</sup> day of September, 2012

  
\_\_\_\_\_  
Jan Tamulewicz

Katten Muchin Rosenman LLP  
Attorneys for Opposer  
575 Madison Avenue  
New York, New York 10022-2585  
(212) 940-8673